

Remarks

Claims 24-27, 31, 32, 34-40, 42 and 47-49 are pending in the subject application. By this Amendment, Applicants have canceled claims 24-27, 31, 32, 34-40, 42 and 47 and added new claims 50-66. Support for the new claims can be found throughout the subject specification and in the claims as originally filed (see, for example, page 8, lines 10-24; page 10, lines 17-31; page 13, lines 20-30; page 16, lines 1-22; and page 24, lines 1-6). Entry and consideration of the amendments and new claims presented herein is respectfully requested. Accordingly, claims 48-66 are currently before the Examiner. Favorable consideration of the pending claims is respectfully requested.

Applicants gratefully acknowledge the Examiner's withdrawal of the objection against claims 24, 38 and 42. Additionally, prior to the issuance of another Office Action in this matter, Applicants respectfully request the courtesy of an interview to discuss the claims and the rejections of record in this matter.

Claims 48-49 were rejected under 35 U.S.C. § 103(a) as obvious over Rondon *et al.* (2000) in view of Chain *et al.* (2000), Groth *et al.* (2000), Berg *et al.* (1982), and if necessary in view of Devine *et al.* (U.S. Patent No. 5,728,551). Applicants respectfully assert that the claimed invention is not obvious over the cited references.

It is fundamental patent law that an obviousness rejection fails if the prior art relied on does not disclose all of the limitations of the claimed invention. *See, e.g., In re Zurko*, 258 F.3d 1379, 1385-86 (Fed. Cir. 2001). Thus, obviousness requires a teaching or suggestion of all limitations in a claim. *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing *In re Royka*, 490 F.2d 981, 985 (C.C.P.A. 1974)).

Applicants note that the Office Action argues that Rondon *et al.* teach the construction of BAC (bacterial artificial chromosome) libraries with DNA isolated from the soil. The Office Action further argues that the reference inherently teaches "integration ... into a chromosome of a selected host cell" because the reference teaches the mutation of BAC with transposons (Final Rejection at pages 4-5). Applicants respectfully submit that this teaching fails to meet the limitations of claim 48 (iv) ("integrating said modified cloning vectors ... into the genome of said selected recipient host cell"). Particularly, the term "genome" is defined as "the complete complement of an organism's genes" (see attached definition from *Biology*, N.A. Campbell, The Benjamin/Cummings Publishing

Company, Inc., 1987 and 1990). Thus, it is clear that a BAC does not meet the definition of a genome nor would those skilled in the art consider or recognize that a BAC was identical to the genome of a selected host cell. Further, it is respectfully submitted that Rondon *et al.* fail to teach the cloning of environmental DNA fragments in *E. coli* and transfer of modified cloning vectors into a recipient host cell that is a microorganism or host cell other than *E. coli*. Chain *et al.*, Groth *et al.*, Berg *et al.* and Devine *et al.* fail to remedy these defects in the teachings of Rondon *et al.* Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a) is respectfully requested because the combination of references fails to establish the *prima facie* obviousness of the claimed invention.

Claims 24-27, 31, 32, 34-40, 42 and 47-49 remain rejected under 35 U.S.C. § 102(b) as being anticipated by Haldimann *et al.* (2001) in view of Chain *et al.* (2000), Groth *et al.* (2000), Berg *et al.* (1982), and if necessary in view of Devine *et al.* (U.S. Patent No. 5,728,551). At the outset, Applicants respectfully request clarification of this rejection. Because the Office Action acknowledges that Haldimann *et al.* fail to teach a number of elements of the claimed invention (see Final Rejection, paragraph bridging pages 13-14), Applicants assume that this rejection was intended to be advanced under 35 U.S.C. 103(a).

As noted above, an obviousness rejection fails if the prior art relied on does not disclose all of the limitations of the claimed invention. *See, e.g., In re Zurko*, 258 F.3d 1379, 1385-86 (Fed. Cir. 2001). Thus, obviousness requires a teaching or suggestion of all limitations in a claim. *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing *In re Royka*, 490 F.2d 981, 985 (C.C.P.A. 1974)).

In this regard, Applicants note that the Office Action acknowledges that Haldimann *et al.* fail to teach a number of limitations of the claimed invention (Final Rejection at pages 13-14). Applicants further note that Haldimann *et al.* also fail to teach the cloning of environmental DNA fragments in *E. coli* and transfer of modified cloning vectors into a recipient host cell that is a microorganism or host cell other than *E. coli* and the selection, identification or cloning of DNA that results in selected phenotype in the recipient host cell selected for the phenotypic change. Chain *et al.*, Groth *et al.*, Berg *et al.* and Devine *et al.* fail to remedy this defect in the teachings of Rondon *et al.* Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a) is

respectfully requested because the combination of references fails to establish the *prima facie* obviousness of the claimed invention.

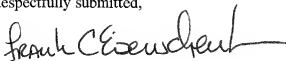
It should be understood that the amendments presented herein have been made solely to expedite prosecution of the subject application to completion and should not be construed as an indication of Applicants' agreement with or acquiescence in the Examiner's position. Applicants expressly reserve the right to pursue the invention(s) disclosed in the subject application, including any subject matter canceled or not pursued during prosecution of the subject application, in a related application.

In view of the foregoing remarks and amendments to the claims, Applicants believe that the currently pending claims are in condition for allowance, and such action is respectfully requested.

The Commissioner is hereby authorized to charge any fees under 37 CFR §§1.16 or 1.17 as required by this paper to Deposit Account No. 19-0065.

Applicants invite the Examiner to call the undersigned if clarification is needed on any of this response, or if the Examiner believes a telephonic interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,



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Attachment: Definition of "genome" from *Biology*